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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,148	09/08/2004	Kazuhiko Honda	34833/US-465122-00004	8978

30873 7590 09/26/2005

DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
250 PARK AVENUE  
NEW YORK, NY 10177

EXAMINER

KOEHLER, ROBERT R

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/507,148

Applicant(s)

HONDA ET AL.

Examiner

Robert R. Koehler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on September 8, 2004 (Prel. Amdt.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09082004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 to 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,465,114 B1 (Honda, et al.).

Honda, et al. discloses a zinc alloy coating on steel material wherein the coating contains significant amounts of aluminum and magnesium. The zinc alloy coating can contain very low amounts of silicon as well as other elements such as calcium, beryllium, titanium, strontium, and nickel. The Examiner notes that the patent does not teach or reasonably suggest the usage of zirconium as an alloying element in the zinc alloy coating. Honda, et al. discloses alloy elemental ranges that overlap applicants' claimed alloy elemental range limits. Although Honda, et al. does not teach or disclose zinc alloy coatings which contain intermetallic compounds as claimed by the applicants and/or zinc alloy coatings which possess metallurgical structures (that is, **(a)** Al-type intermetallic compounds *in an Al phase* and **(b)** Al-type intermetallic compounds *abutting on an Al phase*) as claimed by the applicants, but these claimed features of a zinc alloy coating are believed to be inherent to the zinc alloy coating systems disclosed in the Honda, et al. patent. The Examiner believes that it is reasonable to expect the zinc alloy coating systems disclosed by Honda, et al. to inherently contain the same intermetallic compounds and metallurgical structures as claimed by the applicants because Honda, et al. utilizes the same alloying elements, similar alloy elemental weight percent ranges, and routine zinc alloy coating processes as disclosed by the applicants. It is well settled that

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when a claimed product appears to be substantially the same as a prior art product, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robert Koehler whose telephone number is **(571) 272-1536**. The Examiner can normally be reached on Tuesday to Friday from 9:30 AM to 7:00 PM. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on **(571) 272-1535**. The official Fax No. is **(571) 273-8300**, and the After-Final Fax No. is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).



**ROBERT R. KOEHLER  
PRIMARY EXAMINER**

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September 18, 2005**